

REMARKS

I. Obviousness-Type Double Patenting Rejection

Claims 20-22 and 27-32 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 14-19 of U.S. Patent No. 5,540,908 to Koch et al ("908 Patent"). The double patenting rejection is not proper and the Office Action provides no proper evidence to support the rejection.

The proper question in an obviousness-type double patenting inquiry is whether the *claims* at issue would have been obvious to one of ordinary skill in the art over the subject matter of the *claims* in the first patent, and not the first patent's disclosure. *See e.g., In re Kaplan*, 789 F.2d 1574, 1579-80, 229 U.S.P.Q. 678, 682 (Fed. Cir. 1986). It is clear that the Office Action is relying on the 908 Patent's disclosure as a basis for the rejection since it points to a specific portion of the disclosure as providing a "teaching" that allegedly is probative of the obviousness-type double patent inquiry (Office Action at 4). The law is clear that this is improper. *In re Vogel*, 57 C.C.P.A. 920, 422 F.2d 438, 441, 164 U.S.P.Q. 619, 622 (C.C.P.A. 1970) ("In considering the question, the patent disclosure may not be used as prior art."); *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1275-76 (Fed. Cir. 1992) (test for double patenting is whether or not subject matter of patent claims is obvious from subject matter of claims at issue). And the Office Action points to

no evidence in the 908 Patent claims, the only proper evidence, to support the rejection. Accordingly, the obviousness-type double patenting rejection should be withdrawn.

II. Obviousness Rejection Under 35 U.S.C. § 103

Claims 20-22 and 27-32 also stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the 908 Patent. Applicants traverse this rejection as the cited reference fails to disclose the invention defined in the pending claims.¹

In support of the obviousness rejection, the Office Action argues that the "difference between the [908 Patent] and the instant claims is that the [908 Patent] teaches a genus that encompasses Applicants' claims" (Office Action at 4). Even if that were true, the fact that a claimed species may be within a prior genus is not sufficient by itself to establish a *prima facie* case of obviousness. *In re Baird*, 29 U.S.P.Q.2d 1550 (Fed. Cir. 1994); MPEP § 2144.08, II; *In re Jones*, 958 F.2d 347, 350, 21 U.S.P.Q.2D (BNA) 1941, 1943 (Fed. Cir. 1992) (rejected Commissioner's argument that

¹ During a September 25, 2001 telephone conference with the Examiner, the question of whether the 908 Patent was available as prior art under 35 U.S.C. § 102(e) was discussed. At that time, Applicants were unaware that the assignments in the present case were defective because certain inventors mistakenly assigned their rights to the University of Pennsylvania. In particular, Inventors Baird, Skov, and James should have assigned their rights to The University of British Columbia; and Inventors Dolbier, Jr. and Li should have assigned their rights to The University of Florida Research Foundation, but instead, these inventors incorrectly assigned their rights to the University of Pennsylvania. Applicants are in the process of correcting these assignments and corrected versions of the same will be filed and recorded with the United States Patent and Trademark Office. These corrected assignments should also address the issues raised in the Office Action relating to potential 35 U.S.C. §§ 102(f), 102(g) and 103(c) issues (Office Action at 3).

"regardless [] how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it"). There still must be a teaching that would motivate one skilled in the art to make the claimed invention based on the 908 Patent's disclosure. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2D (BNA) 1596, 1598 (Fed. Cir. 1988) (Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.); M.P.E.P. § 2143.01, 3rd. The Office Action points to no such teaching here.

The Office Action instead erroneously suggests that the 908 Patent at column 6, lines 22 and 23 "gives guidance to prepare the instant compounds" (Office Action at 4). Although the 908 Patent at this location states that the "R₂ substituent is an alkyl group containing 1-6 halogen atoms, and preferably having up to about 6 halogen atoms[, where t]he preferred halogen atom is fluorine," it does not teach making the claimed R₂ having the formula CH₂CX₂CHX₂, as the Office Action incorrectly suggests. The genus disclosed in the 908 Patent contains numerous variables, and there is nothing in the disclosure suggesting that one should select the variables that would result in the claimed compounds. The 908 Patent's preferred compounds, those where R₂ is CH₂CHF₂CF₃ (*see, e.g.,* col. 6:25-26 & col. 12:14-24), does not teach the particular variations required to arrive at Applicants' claimed compounds. Nor do any of the 12 examples teach Applicants' claimed

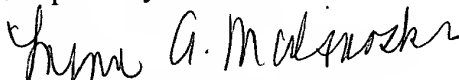
DOCKET NO.: UPN-3904

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invention. Indeed, none of the alkyl groups exemplified in the 908 Patent contain R_2 substituents of the kind claimed (e.g., $-\text{CH}_2\text{CH}_2\text{F}$, $-\text{CH}_2\text{CHF}_2$, CHFCH_2F , $-\text{CHFCHF}_2$, $-\text{CF}_2\text{CH}_2\text{F}$, and $-\text{CF}_2\text{CHF}_2$). And there is no specific teaching in the 908 Patent of making brominated precursors of the kind claimed.

In view of the foregoing, Applicants respectfully request withdrawal of this ground of rejection.

Respectfully submitted,



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Date: December 14, 2001

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